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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,815	03/13/2001	Scott G. Newnam	109.779.129	2040
23483	7590	05/03/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			COLLINS, SCOTT M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/804,815	NEWNAM ET AL.	
	Examiner	Art Unit	
	Scott M. Collins	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-50 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Claims 1-50 examined.
2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment on 01/28/2005.

Response to Arguments

3. Applicant's arguments filed 01/28/2005 have been fully considered but they are not persuasive. Applicant's arguments consist of arguing why the citations used to reject claim 1 are vastly differ from the claimed invention. While the Shoff reference may in some instances differ in terminology from the claimed invention, Shoff teaches a functional equivalent of the claimed invention. Applicant argues that Shoff does not teach downloading episode content before the beginning of an episode, but the episode content must inherently be downloaded before it can ever be viewed, else there would be nothing to view. As for the Walker reference, the reference plainly states that function of his invention may be implemented in the form of a set top device like the type that Shoff has disclosed and thus it would be obvious to implement Walker's invention within Shoff's invention.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 12-22, 24-27, 29-39, and 41-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al., U.S. Patent Application Publication Number US 2001/0001160 A1 (herein referred to as Shoff).

5. Referring to claims 1 and 17, Shoff has taught a method for a user to interact with a server comprising:
 - a. receiving client software for operating on a user-based hardware device that has the ability to control a display, the client software including base software for causing information to be displayed on the display and including software responsive to multiple message types relating to different types of interactivity (Shoff abstract, paragraph 15), program content particular to a certain type of event, and episode content particular to an episode of the event, the receiving of program content and episode content occurring by downloading before the beginning of an episode (Shoff figure 3; abstract, paragraph 39);
 - b. the client receiving from the server messages, each with one of a plurality of message types indicating one of a plurality of types of interactivity related to the episode of the event (Shoff abstract, paragraph 15); and
 - c. the base software using the message type to cause to be displayed on the display content associated with that message type and in a form particular to the message type (Shoff abstract, paragraphs 15, 44).
6. Referring to claims 2 and 18, Shoff has taught the method further comprising for a next episode, downloading the episode content without again downloading the program content and without downloading the base software (Shoff figure 3; paragraphs 39-40).
7. Referring to claims 3 and 19, Shoff has taught the method further comprising for an episode of a different program, downloading the program content and the episode content without downloading the base software (Shoff figure 3; paragraphs 39-40).

8. Referring to claims 4, 20, and 48, Shoff has taught the method wherein the program content relates to a television program, and the episode content is for a particular episode of that television program (Shoff figure 3; paragraphs 39-40).

9. Referring to claims 5 and 21, Shoff has taught the method wherein at least two of the types of interactivity include a question to which the user can respond (Shoff paragraphs 17 and 35).

10. Referring to claims 6 and 22, Shoff has taught the method wherein the types of interactivity include a trivia question (Shoff paragraphs 17 and 35 where a poll is a “question about the program” as given in the example supplemental content types in paragraph 17.).

11. Referring to claim 12 and 24, Shoff has taught the method wherein the client is presentation layer independent (Shoff paragraph 16 where the client is capable of using different presentation layers – the client “launches an interactive support module, such as an Internet browser”).

12. Referring to claim 13 and 25, Shoff has taught the method wherein the client operates with a particular type of presentation software (Shoff paragraph 16 where the client utilizes one type of presentation software at a time).

13. Referring to claims 14 and 35, Shoff has taught the method further comprising sending messages to and receiving messages from other users via the server (Shoff paragraphs 14 and 29).

14. Referring to claims 15 and 33, Shoff has taught the method wherein the episode content includes an advertisement, the base software being responsive to a message type for causing the advertisement to be displayed (Shoff paragraphs 10 and 17 where advertisements are used.).

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15. Referring to claims 16 and 34, Shoff has taught the method wherein the client is responsive to the receipt of a message type and audio or video information for synchronizing the audio or video information to the interactivity indicated by the message type (Shoff paragraph 16).

16. Referring to claims 26-27, 37-39, and 41, Shoff has taught the method further comprising a technical director for managing the server and providing messages to and receiving messages from the server (Shoff paragraphs 14 and 29 where the technical director is simply the piece of software on the server performing the managing.). Shoff has also further taught on message types in the context of all the varied data types sent to the client devices (Shoff figure 3; paragraphs 15 and 39-40).

17. Referring to claim 29, Shoff has taught the method wherein the program is a television program, wherein the technical director provides content to the server for transmission to the users, the content being stored and timed to be received by the user in such a way that the content is synchronized to the television program to display content relevant to the program at that time (Shoff paragraphs 28-30).

18. Referring to claim 30, Shoff has taught the method wherein the content is stored in advance of being displayed and is timed to appear at selected times (Shoff paragraphs 28-30).

19. Referring to claims 31 and 50, Shoff has taught the method wherein the technical director receives content as a human input and provides that content on the fly as a supplement to the content stored in advance (Shoff paragraphs 3-4, and 28-30).

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20. Referring to claim 32, Shoff has taught the method wherein the technical director receives content as a human input and provides that content on the fly to appear at a desired time such that it is relevant to the program at that time (Shoff paragraphs 3-4, and 28-30).

21. Referring to claim 36, Shoff has taught a system for interacting with users comprising:

a. a server having an interface for connection to the Internet infrastructure to provide messages to users that have client software for receiving messages from the server and content that can be displayed (Shoff figure 2 and paragraphs 15 and 31-32);

b. a technical director, responsive to inputs from a producer, for providing to the server different message types that indicate one of a number of different types of interactivity with users, and for providing message content to the server, the message content relating to a specific episode of an interactive event, wherein the technical director can provide to the servers stored messages and message types to cause content to be displayed at desired times during the event, and can also provide content input on the fly (Shoff paragraphs 14 and 29 where the technical director is simply the piece of software on the server performing the managing.);

c. the server, responsive to messages and message types from the technical director, for providing such message types and message content to users (Shoff paragraphs 14 and 29).

22. Referring to claims 42-45, Shoff has taught the method wherein the base software is downloaded through Internet infrastructure and then resides on the hardware device without being downloaded again through Internet infrastructure (Shoff figure 2 and paragraphs 15 and 31-32).

23. Referring to claims 46, 47, and 49, Shoff has taught a method comprising:

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- a. before the beginning of a broadcast episode, a server providing interactive content particular to an episode of a broadcast event from a server to a user-based hardware for storage, the user-based hardware including control software to control the display of interactive content to a user (Shoff figure 3; abstract, paragraphs 15 and 39);
- b. during the broadcast episode, receiving messages from a server or providing messages that indicate a specified part of the previously stored interactive content to be accessed and displayed, and receiving additional content for display during the broadcast (Shoff paragraphs 14 and 29 where the broadcast stream includes additional content).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 7-11, 23, 28, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Shoff in view of Walker et al., U.S. Patent Number 6,331,144 (herein referred to as

Walker).

26. Referring to claim 7-11, 23, 28, and 40, Shoff has generally taught having trivia

information and questions via the user-based hardware device (Shoff paragraphs 17 and 35).

Shoff has not expressly disclosed the specifics of the software being responsive to messages and displaying the questions. Walker has taught an electronic gaming system that allows a player to play a trivia question game (Walker abstract) and has taught that the entire trivia question game

could be implemented in an alternate embodiment of a set top cable box (Walker column 7, lines 26-34) as Shoff and applicant have taught.

27. Referring to claim 7, Walker has taught the method wherein the message type indicates a trivia question, and message includes text for the question, the base software being responsive to the message type for formatting the question as a trivia question and displaying the trivia question (Walker figures 2 and 3a; and column 4, lines 53-63).

28. Referring to claim 8, Walker has taught the method wherein the formatting further includes displaying a point count for the question that changes with time (Walker figures 2 and 3a; column 3, lines 14-28; and column 4, lines 53-63).

29. Referring to claim 9, Walker has taught the method wherein the base software, responsive to a user entering an answer, causes the answer to be provided to the server to determine if it is correct (Walker figures 2 and 3a; and column 4, lines 53-63).

30. Referring to claim 10, Walker has taught the method wherein the base software, responsive to a user entering an answer, checks the answer against an answer stored as episode content (Walker figures 2 and 3a; and column 4, lines 53-63).

31. Referring to claims 11 and 40, Walker has taught the method wherein one of the client and server corrects the answer, the client receiving from the server and displaying a point total for multiple users interacting at the same time with the server (Walker figures 2 and 3a; and column 4, lines 53-63).

32. Referring to claim 23, Walker has taught the method wherein the server is responsive to the base software providing either an answer for correction or an indication that the answer was

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correct for providing to users point totals indicating points in response to the answers provided (Walker figures 2 and 3a; and column 4, lines 53-63).

33. Referring to claim 28, Walker has taught the method wherein questions for responses are initiated from the technical director to the server and thereafter to the users (Walker figures 2 and 3a; and column 4, lines 53-63 where the technical director is simply the piece of software on the server performing the managing.).

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 571.272.3934. The examiner can normally be reached on Mon.-Fri. 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571.272.6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc
April 26, 2005

v. martin wallace
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